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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/16/2001

Omid McDonald

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08/18/2006

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EXAMINER

THAI, HANH B

ART UNIT

PAPER NUMBER

2163

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,828

Applicant(s)

MCDONALD ET AL.

Examiner

Hanh B. Thai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed 6/15/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-22 and 24-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. The following is a Final Office Action in response to the amendment filed June 15, 2006.

Claims 1 and 23 have been cancelled. Claims 2-22 and 24-25 are pending in this application.

Response to Arguments

2. Applicant's arguments regarding "calculating and comparing two CDCs inside the card itself and associating respective CDCs to each record of the electronic token" of claims 2-22 and 24-25 have been considered but not found persuasive.

Ahlgren clearly discloses calculating in the electronic token a change detection code (CDC) for each record in the memory (col.2, lines 57-64, Ahlgren) and comparing the calculated CDC with a stored CDC (col.2, lines 64-67, Ahlgren)

3. Applicant's arguments regarding "preparing a SMS message in the electronic token" have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlgren et al. (US 6,968,209 B1) new cited in view of Dietrich et al. (US 6,879,989 B2).

Regarding claim 6, Ahlgren discloses a method applied by an electronic token for identifying changed records in a memory of the electronic token, the method comprising:

- calculating in the memory a change detection code (CDC) for each record in the memory and storing the respective CDCs in the memory of the electronic token (abstract; col.2, lines 59-62 and col. 4, lines 9-22, Ahlgren discloses calculating checksum stored in the SIM card reads on the claimed “calculating in the memory a change detection code”);
- comparing in the memory the calculated CDC with the stored CDC associated with the record in order to determine if the record has changed since the stored CDC was calculated (abstract; summary; col. 4, lines 24-34 and lines 58-65, Ahlgren) and
- if the calculated CDC is not equal to the stored CDC, and saving the calculated CDC of the record as the stored CDC of the record (abstract; summary and col. 4, lines 35-54, Ahlgren).

Ahlgren, however, does not disclose preparing a SMS message in the electronic token and sending the message to a registering element. Dietrich discloses short message service for a mobile radio network including generating a short message service and sending the message to the subscriber (see summary; col. 2, line 48 to col. 3, line 10, Dietrich). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide a short message service of Dietrich into the Ahlgren's system to derive the invention as claimed. The motivation of doing so would have been to provide efficient and reliable use of the short message in updating records of the mobile device (col.1, lines 60-63, Dietrich).

Regarding claim 2, Ahlgren/Dietrich combination further discloses a step of calculating a cyclic redundancy check (col.4, lines 10-22, Ahlgren).

Regarding claim 3, Ahlgren/Dietrich combination further discloses a step of determining if the at least one associated record is changed and yields information regarding the change, the information being input to the predefined algorithm (summary; col.3, lines 11-21; col. 4, lines 24-34 and lines 58-65, Ahlgren).

Regarding claim 4, Ahlgren/Dietrich combination further discloses the step of issuing a message to an electronic token reader in which the electronic token is docked, the message containing at least one parameter regarding the change for use by a registering element to which the message is sent by a token-resident applet via the electronic token reader (col.3, lines 11-21; col. 4, lines 24-34 and lines 58-65, Ahlgren).

Regarding claim 5, Ahlgren/Dietrich combination disclose a step of setting a response pending flag which is cleared if an acknowledgement of the message is received, wherein the flag is used to indicate that a message was not acknowledged (col.4, lines 46-53 and line 66 to col.5, line 6, Ahlgren).

Regarding claim 7, Ahlgren/Dietrich combination disclose a step of using any flag set in association with the stored CDC, in conjunction with the values of the stored CDC and calculated CDC to determine if the record was changed since a last acknowledged message related to the record was sent (summary; col. 2, line 48 to col. 3, line 10, Dietrich).

Regarding claim 8, Ahlgren/Dietrich combination disclose a step of sending the message to the registering element, which performs at least one of: synchronization of data across multiple data stores; update of a system with respect to the record; back-up of the record; and provision of a service feature in dependence on the change to the record (col.4, lines 46-53 and line 66 to col.5, line 6, Ahlgren).

Regarding claim 9, Ahlgren/Dietrich combination disclose steps of issuing a short message service message to a service provider that has access to the registering element (summary; col. 2, line 48 to col. 3, line 10, Dietrich).

Regarding claim 10, Ahlgren/Dietrich combination disclose steps of: receiving information relating to the change; formulating a notice of change (NOC) message; and inserting as many NOC messages as possible into the SMS message before sending the SMS message (col.3, lines 11-21; col. 4, lines 24-65, Ahlgren).

Regarding claim 11, Ahlgren/Dietrich combination disclose that the electronic token is a subscriber identity module and the step of comparing further comprises a step of applying a comparison algorithm that executes on the subscriber identity module, the comparison algorithm being adapted to compare a CDC of each of a plurality of abbreviated dialing numbers in the file; and the step of issuing comprises a step of directing a SMS message to the registering element, which is adapted to perform at least one of the following: ensure conformity of the file with other versions of the file stored elsewhere; back-up the file; and, provide a service feature in dependence on the change (col.3, lines 11-21; col. 4, lines 24-34 and lines 58-65, Ahlgren).

Regarding claim 12, Ahlgren/Dietrich combination disclose steps of formulating the message by inserting the at least one parameter into respective fields of the message, and forwarding the message to the registration element (summary; col. 2, line 48 to col. 3, line 10, Dietrich).

Regarding claim 13, Ahlgren/Dietrich combination disclose steps of inserting a record identifier, and information that specifies the change (col.4, lines 46-53 and line 66 to col.5, line 6, Ahlgren).

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Regarding claim 14, Ahlgren/Dietrich combination disclose a step of inserting a value that indicates one of the following: the record was added; the record was deleted; and the record was modified (col.3, lines 11-21; col. 4, lines 24-65, Ahlgren).

Regarding claim 15, Ahlgren discloses an apparatus for providing a service to a subscriber having an electronic token, the apparatus comprising:

a change detection applet stored on the electronic token including a microprocessor and a memory, the electronic token storing a set of records and change detection codes (CDCs) respectively associated with the records respectively associated with the records, the CDCs identifying a version of the stored record (abstract; col.2, lines 59-62 and col. 4, lines 9-22, Ahlgren discloses log file of records and a checksum stored in the SIM card reads on the claimed “electronic token storing a set of records and change detection codes”), said applet being adapted to be executed by the microprocessor of the electronic taken and adapted to identify any record that has been changed since a change detection code (CDC) for the record was stored in the card (summary; col. 4, lines 24-34 and lines 58-65, Ahlgren) by calculating a current CDC for the record and comparing such current CDC with the stored CDC (summary; col. 4, lines 24-65, Ahlgren).

Ahlgren, however, does not disclose preparing a SMS message in the electronic token and sending the message to a registering element. Dietrich discloses short message service for a mobile radio network including generating a short message service and sending the message to the subscriber (see summary; col. 2, line 48 to col. 3, line 10, Dietrich). It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to provide a short message service of Dietrich into the Ahlgren's system to derive the invention as claimed. The motivation of doing so would have been to provide efficient and reliable use of the short message in updating records of the mobile device (col.1, lines 60-63, Dietrich).

Regarding claim 16, Ahlgren/Dietrich combination discloses the change detection applet calculates a cyclic redundancy check (CRC) to derive the current CDC (col.4, lines 10-22, Ahlgren).

Regarding claim 17, Ahlgren/Dietrich combination discloses back up records for which the NOC message was generated; synchronize the file with other files remotely stored but commonly associated with a subscriber; and, provide a service dependent upon the detected change (col.4, lines 10-65, Ahlgren).

Regarding claim 18, Ahlgren/Dietrich combination discloses the electronic token is docked in a communications enabled device that comprises an electronic token reader adapted to exchange data in conformity with a predetermined protocol (col.3, lines 11-21; col. 4, lines 24-34 and lines 58-65, Ahlgren).

Regarding claim 19, Ahlgren/Dietrich combination discloses a subscriber identity module (SIM) card compliant with a global system for mobile communications (GSM) standard; and a universal SIM (USIM) card (see Fig.1-3 and corresponding text, Ahlgren).

Regarding claim 20, Ahlgren/Dietrich combination discloses the communications enabled device is adapted to function as a short message service (SMS) enabled telephone (col.3, lines 11-21; col. 4, lines 24-34 and lines 58-65, Ahlgren).

Regarding claim 21, Ahlgren/Dietrich combination discloses a data store for storing a set of response pending flags that are associated with a list of records in the file, and the change detection applet is further adapted to use the set of response pending flags to determine if a record may have been changed since a last NOC message for the record was acknowledged (col.4, lines 46-53 and line 66 to col.5, line 6, Ahlgren).

Regarding claim 22, Ahlgren/Dietrich combination discloses the set of response pending flags comprises at least two flags used to encode change information, and the change detection applet is further adapted to use the plurality of flags, in conjunction with the stored CRC and current CRC, to determine if a notice of change message related to the record is to be sent (summary; col. 2, line 48 to col. 3, line 10, Dietrich).

Regarding claims 24-25, Ahlgren discloses a change applet stored on an electronic token including a microprocessor and a memory, the electronic token storing a set of records and change detection codes (CDCs) respectively associated with the record, the CDCs identifying a version of the stored record, said applet being adapted to be executed by the microprocessor of the electronic token and adapted to identify any record that has been changed since a change detection code (CDC) of the record was stored in the card (abstract; col.2, lines 59-62 and col. 4, lines 9-22, Ahlgren discloses log file of records and a checksum stored in the SIM card reads on the claimed “electronic token storing a set of records and change detection codes”), by calculating a current CDC for the record and comparing such current CDC with the stored CDC (col.2, lines 59-62 and col. 4, lines 9-65 Ahlgren discloses calculating checksum stored in the SIM card and comparing the checksum reads on the claimed “calculating a current CDC” and “comparing current CDC with the stored CDC”).

Ahlgren, however, does not disclose preparing a SMS message in the electronic token and sending the message to a registering element. Dietrich discloses short message service for a mobile radio network including generating a short message service and sending the message to the subscriber (see summary; col. 2, line 48 to col. 3, line 10, Dietrich). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide a short message service of Dietrich into the Ahlgren's system to derive the invention as claimed. The motivation of doing so would have been to provide efficient and reliable use of the short message in updating records of the mobile device (col.1, lines 60-63, Dietrich).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Kim (US 6,161,020) discloses mobile radio terminal with SMS function for transmitting short message and method for controlling the same.

2. Henry et al. (US Pub. 2001/0046854 A1) disclose method of remotely updating the software of a mobile telephone terminal.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

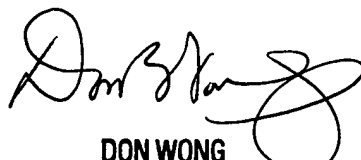
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh B. Thai whose telephone number is 571-272-4029. The examiner can normally be reached on 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hanh B Thai
Examiner
Art Unit 2163

August 7, 2006


DON WONG
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